

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/786,379
Applicant : Kim, et al.
Filed : February 25, 2004
Docket No. : YOU102

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: Director of Technology Center 3600

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LICENSING & REVIEW

PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
PURSUANT TO 37 CFR §§5.14(a) AND 5.25

Sir:

Pursuant to 37 CFR §5.14(a) and 37 CFR §5.25, petition is hereby made for a retroactive license under 35 U.S.C. §184 and 37 CFR §5.12(b) for the foreign filing of subject matter for which a corresponding U.S. application has been filed.

The corresponding U.S. application is identified as Serial No. 10/786,340 filed on February 25, 2004 by inventors Hyung-Joon Kim, Jinming Zhang, Richard D. Grandour, and Roe-Hoan Yoon, and entitled Method of Improving the Performance of Organic Coatings for Corrosion Resistance (the "U.S. application"). The named inventors include a Korean citizen who resides in Korea and U.S. citizens who reside in the United States. The assignees include Posco, a company in Korea, and Virginia Tech Intellectual Properties, Inc., a company in the United States.

A foreign filing license was granted on May 18, 2004 in the corresponding U.S. application, as indicated in the filing receipt mailed May 18, 2004. Because an application corresponding to the U.S. application was first filed abroad without a foreign filing license, Petitioner requests that the foreign filing license granted May 18, 2004 be made retroactive.

The corresponding application was first filed in the Korean Intellectual Property Office (KIPO) on December 16, 2003 (the "Korean application"). See Lee Declaration, ¶ 2. The

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Korean application was filed by a Korean firm, the You Me Patent & Law Firm, which represents the Korean company Posco.

Pursuant to 37 CFR §5.25(a)(3), a verified statement is submitted herewith in the form of a Declaration of Lee, Yong-Kyoo (the "Lee Declaration") an attorney of the You Me Patent & Law Firm having personal knowledge of the events referenced herein. See Lee Declaration, ¶ 1. In accordance with 37 CFR §5.25(a)(3)(i), the Lee Declaration includes an averment that the subject matter of the application was not under a secrecy order at the time it was filed abroad and is not currently under a secrecy order. See Lee Declaration, ¶ 3.

In accordance with 37 CFR §5.25(a)(3)(ii), the Lee Declaration shows that a license was diligently sought after discovery of the proscribed foreign filing. In particular, the need for a retroactive foreign filing license was realized only after filing of the Korean application. See Lee Declaration, ¶ 4. The Korean application was withdrawn on April 23, 2004 in the belief that withdrawal of the application would satisfy the U.S. foreign filing license requirements. See Lee Declaration, ¶ 5. This Petition for Retroactive Foreign Filing License was promptly drafted and filed with the USPTO after discovery of the need for a retroactive foreign filing license. See Lee Declaration, ¶¶ 4-5.

In accordance with 37 CFR §5.25(a)(3)(iii), the Lee Declaration further explains why the material was filed abroad without the required license through error and without deceptive intent. In particular, the Korean firm responsible for filing the Korean application on behalf of its Korean client was unaware that the U.S. patent laws required a foreign filing license before filing the Korean application. See Lee Declaration, ¶ 4. After the Korean firm became aware of the foreign filing license requirement, the Korean firm withdrew the Korean application and believed that a foreign filing license was no longer required because the Korean application had been withdrawn. See Lee Declaration, ¶ 5.

Accordingly, Petitioner requests that a retroactive foreign filing license be granted pursuant to 37 CFR §§5.14(a) and 5.25 and delivered to the undersigned attorney of record.

In accordance with 37 CFR §5.25(4), the petition fee of \$130 set forth in 37 CFR §1.17(h) is submitted herewith. Please apply any charges not covered, or any credits, to Deposit Account 50-2121 (Reference Number YOU102).

Date: 7/8/04

Respectfully submitted,

GROSSMAN, TUCKER, PERREAULT &
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